



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,949	06/21/2001	Isabelle Afriat	209060US	2772

22850 7590 01/11/2006

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

COTTON, ABIGAIL MANDA

ART UNIT PAPER NUMBER

1617

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/884,949

Applicant(s)

AFRIAT, ISABELLE

Examiner

Abigail M. Cotton

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>August 16, 2005</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 16, 2005 has been entered.

Claims 1-30 are pending in the application.

Applicant's arguments filed August 16, 2005 have been fully considered but they are not persuasive. In particular, the rejection of claims 1-22 and 25-30 as being obvious over U.S. Patent No. 5,567,426 to Naduad et al, issued October 22, 1996, and the rejection of claims 23 and 24 as being obvious over Naduad et al. in view of Hawley's Condensed Chemical Dictionary, as set forth in the Office Action dated April 19, 2005, are being maintained. The rejections under the judicially created doctrine of obviousness type double patenting of claims 1-9 and 23-29 over U.S. Patent No. 6,465,510, claims 1-29 over U.S. Patent No. 6,331,306 and claims 1-9 and 23-29 over U.S. Patent No. 6,562,354, as set forth in the Office Action dated October 4, 2004 and the Office Action dated April 19, 2005, are also being maintained. Please see below for a discussion of the rejections.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-22 and 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,567,462 to Naduad et al, issued October 22, 1996.

Naduad et al. discloses a substantially similar water-in-oil emulsion or a substantially similar cosmetic composition comprising the substantially similar ingredients in the same amounts as instantly claimed, that is useful in the same method of treating, caring for, removing make-up from and/or cleansing the skin and/or hair comprising applying the same composition herein. See the specific and particular water-in-oil emulsion or cosmetic compositions disclosed in Examples 1 and 3-12 at column 11-17, in particular. In particular, Naduad et al. discloses the use of the emulsifier herein, dimethicone copolyol comprising oxyalkylene having the formula shown at column 3, lines 17-36, wherein the ratio of oxyethylene groups to oxypropylene groups of C<sub>2</sub>H<sub>4</sub>O/C<sub>3</sub>H<sub>6</sub>O is between 100:0 and 20:80, such as the product sold under the name "ABIL WE 09" (see column 3, lines 37-38, in particular.)

Art Unit: 1617

Thus, the disclosure of Naduad et al. provides for a dimethicone copolyol wherein the ratio of oxyethylene groups to oxypropylene groups is selected in a range between 100:0 to 20:80, which allows for a compound in which only a very small or even close to zero oxypropylene groups are present, such as a ratio of oxyethylene to oxypropylene groups of 100:1, or even 100:0.0001, or an even smaller amount of oxypropylene. It is furthermore noted that oxypropylene is a homolog of oxyethylene by addition of methyl (CH<sub>3</sub>) group.

The particular emulsion of Example 1 (see column 11-12, in particular) comprises: an aqueous phase (as taught at column 6, lines 31-38): water =  $4 + (100 - \text{the weight of all other non-water ingredients}) = 4 + (100 - 36.26) = 67.74$  g; propylene glycol (which meets the limitations of claims 25 and 27 herein) =  $4 + 20$  g; glycerin (also called glycerol which meets the limitations of claim 26 herein) =  $0.4 + 2 = 2.4$  g; sodium chloride (or one electrolyte which meets claims 28-29 herein) =  $0.16$  g; preservative dyes =  $0.6$  g. Thus, the total weight percent of the aqueous phase is 94.9% by adding up all the weight of ingredients in the aqueous phase, which meets the limitation herein of at least 80%.

Naduad et al. further teaches the weight ratio of the oily phase =  $0.5$  g per  $100$  g or 0.5% of "ABIL WE 09" (which meets claim 5 herein) +  $0.8$  g of silicone gum +  $2.7$  g of volatile silicone oil (which meets claim 22 herein) =  $4$  g. Thus, the weight ratio of the

Art Unit: 1617

oily phase to the emulsifier "ABIL WE 09" is  $4:0.5 = 8$ , which meets the limitations herein of "greater than or equal to 5 or 8."

The particular emulsion of Example 3 (see columns 12-13) comprises: water =  $11.1 + (100 - \text{the weight of all other non-water ingredients}) = 11.1 + (100 - 40.2) = 70.9 \text{ g}$ , which meets the limitations herein of "at least 70% by weight water relative to the total weight of the composition." The weight percent of the oily phase =  $0.6 + 0.2 + 1 + 3.4 + 5 = 10.2 \text{ g per } 100 \text{ g}$  or 10.2% which meets the limitation herein of the "oily phase is present in an amount ranging from 10% to 18% by weight" as in claims 6 and 13 herein.

Regarding the inherent property of viscosity, as recited in the claims herein, it is noted that it has been well settled that recitation of an inherent property of a composition will not further limit claims drawn to a composition, so long as the prior art discloses the same composition comprising the same ingredients in the same amount as instantly claimed.

Naduad et al. does not expressly disclose the employment of oxyethylene groups in a dimethicone copolyol emulsifier, absent any oxypropylene groups.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ oxyethylene groups only in a dimethicone copolyol as an emulsifier used in the substantially similar water-in-oil emulsion of Naduad et al.

One of ordinary skill in the art at the time the invention was made would have been motivated to employ oxyethylene groups only in a dimethicone copolyol as the emulsifier used in the substantially similar water-in-oil emulsion of Naduad et al, because Naduad et al. teaches that the dimethicone copolyol can comprise oxyethylene groups in a ratio to oxypropylene groups that allows for only a very small amount of oxypropylene groups, such as close to zero oxypropylene groups, as long as a weight ratio of oxyethylene to oxypropylene groups is between 100:0 to 20:80. Furthermore, it is noted that oxypropylene and oxyethylene are homologs of one another that differ only by a methylene (-CH<sub>2</sub>-) group.

Therefore, one of ordinary skill in the art would have reasonably expected that the dimethicone copolyol comprising oxyethylene groups only would possess the same or substantially similar properties and usefulness as the prior art dimethicone copolyol because of the substantially close structural relationship. Moreover, as noted in MPEP 2144.09, homologs (compounds differing regularly by the successive addition of the same chemical groups, e.g., by -CH<sub>2</sub>- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. In re Wilder, 563 F.2d 457, 195 USPQ 426 (CCPA 1977.) See also In re May, 574 F.2d 1082, 197 USPQ 601 (CCPA 1978) (stereoisomers prima facie obvious.) If the claimed invention and the structurally similar prior art species share any useful property, that will generally be sufficient to motivate an artisan of ordinary skill to

Art Unit: 1617

make the claimed species. In fact, similar properties may normally be presumed when compounds are very close in structure. Dillon, 919 F.2d at 693, 696, 16 USPQ2d at 1901, 1904.

Thus, the claimed invention is deemed to be obvious over the cited prior art.

Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naduad et al, as applied to claims 1-22 and 25-30 above, in view of Hawley, G.G., The Condensed Chemical Dictionary, 10 Ed., Van Nostran Reinhold Co. New York, NY, 1981, page 423.

The disclosure of Naduad et al. is applied as discussed for claims 1-22 and 25-30 above. Naduad et al. does not expressly disclose the employment of ethanol in the cosmetic emulsion or composition.

Hawley teaches that ethanol is a common ingredient in cosmetics and acts as a solvent for fats and oil.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to further employ ethanol with water in the cosmetic emulsion of composition of Naduad et al. One having ordinary skill in the art at the time the invention was made would have been motivated to further employ ethanol with water in



Art Unit: 1617

the cosmetic emulsion or composition of Naduad et al. because ethanol is old and well known to be a water-like solvent, being miscible with water, and a common ingredient in cosmetics and acts as a solvent for fats and oils as taught by Hawley. Thus, replacing at least some water with ethanol is considered to be conventional in the cosmetic art.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 and 23-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S.

Patent No. 6,465,510 for the same reasons of record stated in the Office Actions dated October 4, 2004, and April 19, 2005.

Although the conflicting claims are not identical, they are not patentable distinct from each other because the patent is drawn to an emulsion and cosmetic composition for skin comprising the same ingredients including the same emulsifier as herein, a dimethicone copolyol, in the same amounts. Thus, these emulsion and cosmetic composition between the parent and the instant application are seen to substantially overlap. Accordingly, the instant claims 1-9 and 23-9 are seen as obvious over the claims 1-13 of U.S. Patent No. 6,465,510.

Claims 1-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,331,306 for the same reasons of record stated in the Office Actions dated October 4, 2004 and April 19, 2005.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent is drawn to an emulsion and cosmetic composition for skin comprising the same ingredients including the same emulsifier as herein, a dimethicone copolyol in the same amounts, and the same method or process of use of the composition as instantly claimed. Thus, the emulsion and cosmetic compositions and methods of the patent and in the instant application are seen to substantially

overlap. Thus, the instant claims 1-29 are seen to be obvious over the claims 1-16 of U.S. Patent No. 6,331,306.

Claims 1-9 and 23-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of U.S. Patent No. 6,562,354 for the same reasons of record stated in the Office Actions dated October 4, 2004 and April 19, 2005.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent is drawn to an emulsion and cosmetic composition for skin comprising the same ingredients including the same emulsifier as herein, a dimethicone copolyol, in the same amounts. Thus, the emulsions and cosmetic compositions of the patent and in the instant application are seen to substantially overlap. Thus, the instant claims 1-9 and 23-29 are seen to be obvious over claims 1-34 of U.S. Patent No. 6,562,354.

Claims 1-29 are rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,239,174 for the same reasons of record stated in the Office Actions dated October 4, 2004 and April 19, 2005.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent is drawn to an emulsion and cosmetic composition for skin comprising the same ingredients including the same emulsifier as herein, a dimethicone copolyol in the same amounts, and the same method or process of use of the composition as instantly claimed. Thus, the emulsions and cosmetic compositions and methods of the patent and the instant application are seen to substantially overlap. Thus, the instant claims 1-29 are seen to be obvious over the claims 1-26 of U.S. Patent No. 6,239,174.

### ***Response to Arguments***

Applicant's arguments filed August 16, 2005 have been fully considered but they are not persuasive.

Applicants argue that Naduad et al. does not teach water in oil emulsions, as recited in the instant claims. The Examiner respectfully directs Applicants to the formulation examples of Naduad et al, specifically Examples 1 and 3, which teach water in oil emulsions as a part of triple emulsion compositions. Accordingly, Naduad et al. exemplifies compositions comprising water-in-oil emulsions as recited in the instant claims.

Applicant's further argue, and provide evidence via a 132 Declaration signed by Chevalier Veronique, asserting that a dimethicone copolyol having only oxyethylene groups, namely KF-6015, provides unexpected results over dimethicone polyols having both oxyethylene and oxypropylene groups. Applicant's argue that the two types of surfactants do not possess similar properties, because the surfactant with only oxyethylene groups exhibits better cycle stability than surfactants having both oxyethylene and oxypropylene groups.

The Examiner notes that the closest prior art of record, Naduad et al, discloses a dimethicone copolyol that can have a weight ratio of oxyethylene to oxypropylene groups that allows for very few and even close to zero oxypropylene groups, as long as the ratio of oxyethylene groups to oxypropylene groups is between 100:0 to 20:80. It is also noted that oxypropylene is a homolog of oxyethylene, and thus is expected to have similar properties, as discussed above.

Applicant's arguments and evidence via the 132 Declaration does not provide a showing that is sufficient to overcome the prima facie case of obviousness, as the evidence provided by Applicants does not show unexpectedly good results for the dimethicone copolyol having only oxyethylene groups as claimed. Applicants assert that the two types of surfactants do not possess similar properties, and thus are not obvious over one another. However Applicant's own declaration shows that both surfactants, the dimethicone copolyol having only oxyethylene groups (KF-6015) as well

Art Unit: 1617

as the dimethicone copolyols having both oxyethylene and oxypropylene groups (DC 2-5185 and Silwet FZ-2108), show cycle stability for at least two days. Thus, the surfactants do possess similar properties, namely cycle stability, and thus exhibit properties that are consistent with those expected of structural homologs.

Regarding the magnitude of the cycle stability, namely the slightly increased cycle stability (5 days) of the dimethicone copolyol having only oxyethylene groups over the dimethicone copolyols homologs having a mixture of oxyethylene and oxypropylene groups (2 days), it is considered that one of ordinary skill in the art would expect that even structural homologs would exhibit some slight variations in properties, that is, some homologs are expected to show slightly better or worse properties than others. Thus, the fact that the dimethicone copolyol having only oxyethylene groups has somewhat better cycle stability than its structural homologs is not considered to be "unexpected," and does not constitute an unexpectedly good result that is sufficient to overcome a prima facie rejection of obviousness based on Naduad et al's teaching of a dimethicone polyol that can have a ratio of oxyethylene to oxypropylene groups that is between 100:0 to 20:80. It is noted that any differences between the claimed invention and the prior art may be expected to result in some differences in properties. The issue is whether the properties differ to such an extent that the difference is really unexpected. In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986.)

It is furthermore noted that Applicants do not specify whether the emulsions as tested in the 132 Declaration were commensurate in scope with the claims. In particular, it is not clear whether the tested emulsions had an aqueous phase of at least 80% by weight and an oily phase and emulsifier in a weight ratio greater than or equal to 5, as required by the claims, or whether these were another type of emulsion. The declaration only specifies that the inventive composition and comparative compositions were identical with the exception of the dimethicone copolyol used (see paragraph 4, in particular), it does not specify that the compositions comprising the percents by weight of the aqueous phase and weight ratio of oily phase to emulsifier were as claimed. It is noted that "objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support." In re Clemens, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980.)

Regarding Applicants argument over the obviousness-type double patenting rejections, it is noted that Applicants argues that the cited patents do not claim "only oxyethylene groups" and specific pH ranges as well as the presence of ascorbic acid. It is firstly noted that these rejections are based on **obviousness**-type double patenting. Thus, "only oxyethylene groups" and the specific pH ranges as well as the presence of ascorbic acid are deemed to be obvious variants in view of the patents. Secondly, as discussed above, the limitation "only oxyethylene groups" is considered to be obvious over oxyethylene groups and oxypropylene groups.

***Conclusion***

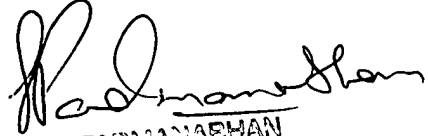
No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abigail M. Cotton whose telephone number is (571) 272-8779. The examiner can normally be reached on 9:30-6:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMC

  
SREENIVASAN PADMANABHAN  
SUPERVISORY PATENT EXAMINER